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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 68143(70820)	
		Application Number 10/500,999-Conf. #3369	Filed October 1, 2004
		First Named Inventor Jun-Ichi Kawakami et al.	
		Art Unit 1626	Examiner L. Stockton
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor. _____ Signature /Nicholas J. DiCeglie, Jr./</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) _____ Nicholas J. DiCeglie, Jr. Typed or printed name</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 51,615 _____ (212) 308-4411 Telephone number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____ February 17, 2009 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p>			

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: February 17, 2009

Electronic Signature for Nicholas J. DiCeglie, Jr.: /Nicholas J. DiCeglie, Jr./

Docket No.: 68143(70820)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jun-Ichi Kawakami et al.

Application No.: 10/500,999

Confirmation No.: 3369

Filed: October 1, 2004

Art Unit: 1626

For: PROCESS FOR PRODUCING FUSED
IMIDAZOLE COMPOUND, REFORMATSKY
REAGENT IN STABLE FORM, AND
PROCESS FOR PRODUCING THE SAME

Examiner: L. Stockton

**REMARKS/ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants are in receipt of the final Office Action dated August 21, 2008 (the "Office Action"), and now request review of the Office Action. A Notice of Appeal is filed herewith. The following remarks support Applicants' "Pre-Appeal Brief Request for Review" filed herewith. These remarks do not exceed five pages, do not present amendments, and are being filed with a Notice of Appeal, thereby satisfying the requirements for review.

The Office Action

In the Office Action, Claims 22-25 and 30 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Dekker et al. (*Organometallics*, 3(9), pp. 1403-1407, 1984). The Office Action alleges that Dekker et al. disclose the ethyl ester of bromoacetic acid in dimeric form. The Office Action specifically points to Dekker's abstract on page 1403, Table II in the second column of 1404, and the "Discussion" on page 1406 in column 1 and column 2, as well as equilibria (2) on line 3.

This rejection was traversed in the Response filed December 19, 2008 ("Response of December 19, 2008"). However, according to the Advisory Action, the rejection was maintained. Applicants again disagree and traverse the rejections.

Clear Error and/or Omission in the Final Office Action:

The Dekker reference does not anticipate the present claims

As discussed in the Response of December 19, 2008, Applicant submits that Dekker et al. **did not obtain a crystal** of $(\text{BrZnCH}_2\text{COOC}_2\text{H}_5 \cdot \text{THF})_2$. As such, the Dekker reference does not teach or suggest the features of the present invention. As such, it is insufficient to sustain the rejection.

The Office Action asserts at page 4, 2nd line from the bottom "...the reagents (i.e., the ethyl reagent) are formed and isolated in solid form." Reference is made to Dekker et al. at page 1404, column 1, "Preparation of the Reagent".

Applicant acknowledges that a tert-butyl reagent and an ethyl reagent were obtained in solid forms. However, for the ethyl reagent, Dekker et al. states: "For the ethyl reagent this [Applicant's notation: isolation] was done by evaporation of the solvent (yield 75%)" (Emphasis added). On the other hand, for the tert-butyl agent, Dekker et al. states "tert-butyl reagent was isolated by concentrating the supernatant liquid, after which [Applicant's notation: isolation] the reagent crystallized" (Emphasis added).

Accordingly, Dekker et al. obtained the ethyl reagent as a solvent-free solid isolation but **not as a crystal**. Dekker et al. did obtain the tert-butyl reagent as a crystal. This demonstrates that among the solid form of reagents, only the tert-butyl reagent could be obtained in a crystalline form and the ethyl reagent could not be crystallized.

The Office Action further alleges at page 4, bottom line, to page 5: "On page 1404 in column 2, the last sentence before "Results", Dekker et al. disclose the reference, instrumentation, and program used for crystal structure determination."

Applicant submits that it is amply clear that the description of Dekker et al. on page 1404 in column 2 refers only to crystals of the tert-butyl reagent as the title of that section is "Data Collection and Structure Determination of (BrZnCH₂COOt-bu·THF)₂."

The Office Action also asserts at page 5, line 3, to page 6, line 8: "On page 1404 in column 3, under "Results", Dekker et al. states...[that they] have employed molecular weight measurements to determine the degree of association of the Reformatsky reagents derived from both the ethyl and the tert-butyl ester of bromoacetic acid." The Office action contends that "hence, Dekker et al. disclose the ethyl ester of bromoacetic acid in dimeric form."

Applicant acknowledges that Dekker et al. discloses a reagent of ethyl ester of bromozincacetic acid in dimeric form. However, Applicant asserts that Dekker et al. **did not obtain any crystal** of (BrZnCH₂COOC₂H₅·THF)₂, as discussed above.

Additionally, Dekker et al. stated in a previous journal article (*J. Chem. Soc., Chem. Commun.* (1983) pages 553-555; copy submitted with the Response of December 19, 2008) which was published prior to the publication date of the cited document and related to the same two Reformatsky reagents: "In our exploration of organozinc co-ordination chemistry, we have been studying the classical Reformatsky reagent (1) derived from BrCH₂CO₂Et. Since no single crystals of this species could be obtained, this study had to be confined to the characterization of the species in solution." See page 554, column 1 (emphasis added). This supports Applicant's position that Dekker et al. has not obtained crystals of (BrZnCH₂COOC₂H₅·THF)₂.

In sum, Dekker's ethyl reagent did not crystallize and Dekker et al. was not able to obtain crystals of ethyl bromozincacetate according to the present invention. Only the tert-butyl reagent could be obtained in a crystalline form.

Indeed, the cited reference fails to teach or suggest the features of the claimed invention. Consequently, Dekker et al. does not anticipate the present invention. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 22-25 and 30 under 35 USC §102(b) over Dekker et al.

CONCLUSION

For at least the foregoing reason, Applicants contend that the rejection of record should be withdrawn, and that the present application is in condition for allowance. Early and favorable consideration of the application is earnestly solicited.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 68143 (70820).

Dated: February 17, 2009

Respectfully submitted,

Electronic Signature:

/Nicholas J. DiCeglie, Jr./

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